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DAC #13

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gil et al.

Examiner: Fay, Z.

OFFICE OF PETITIONS

Serial No.: 10/039, 827

Group Art Unit: 1614

Conf. No.: 9534)

Filed: October 19, 2001

For: Methods and Composition for
Modulating Alpha Adrenergic Receptor
Activity

SEP 05 2003

TECH CENTER 1600/2900

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PETITION UNDER 37 CFR § 1.181 TO WITHDRAW HOLDING OF ABANDONMENT
AND PROVISIONAL PETITION TO REVIVE FOR UNINTENTIONAL DELAY

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 CFR §1.181, Applicants hereby respectfully petition the Commissioner to exercise his authority to withdraw the holding of abandonment for failure to file a timely response to the Office Action mailed January 29, 2003 during prosecution of the above-referenced patent application.

Applicants received a Notice of Abandonment on August 18, 2003 alleging that a Reply to the July 17, 1998 Office Action was not made.

However, Applicants indeed did file a timely response to the July 17, 1998 Office Action. The Reply was filed under a Certificate of Mailing dated June 30, 2003 with a stamped, self-addressed envelope indicating receipt on July 2, 2003 of the items included in the Reply. Copies of the Notice of Abandonment, the Reply, The Transmittal Sheet and a copy of the stamped postcard are enclosed as supporting evidence of the veracity of the Applicants' statement of these facts.

Accordingly, Applicants respectfully maintain that the above-referenced application was held to be abandoned in error, and further request that this holding be withdrawn and prosecution resumed.

As this Petition is being filed under 37 CFR § 1.181, no fee is thought to be due in connection herewith. However if applicants are in error please use Deposit Account 01-0885 for the payment of any fee due regarding this Petition.

17349CIP (HL)
Serial No. 10/039, 827

PATENT

Should this Petition be denied for any reason, please treat this communication as a Petition to Revive due to unintentional delay under 37 CFR 1.137(b). Any and all delay from the date of mailing the Reply to the Office Action until the present date was purely unintentional. In such event, the Commissioner is authorized to use the abovementioned Deposit Account for the payment of the petition fee under 37 CFR §1.17(m).

Respectfully Submitted,

ALLERGAN

Date: 8/26/03

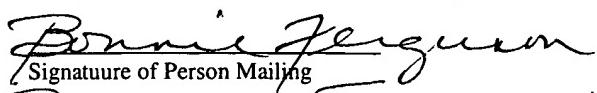
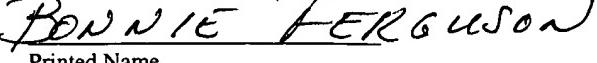
Signature:

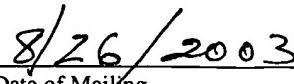

Carlos A. Fisher

Registration No. 36,510

Certificate of Mailing

I hereby certify that this correspondence (along with anything referred to as being attached or enclosed herewith) is being deposited on the date indicated below with the U.S. Postal Service as First Class Mail addressed to Mail Stop Petition, P.O. Box 1450, Commissioner for Patents, Alexandria, VA 22313-1450.


Signature of Person Mailing

Printed Name


Date of Mailing

AUG 29 2003

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OFFICE OF PETITIONS

Notice of Abandonment

Application No.

10/039,827

Applicant(s) AUG 18 2003

Examiner

Zohreh Fay

CHOW

LEGAL/PATENTS

Art Unit

1614

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address

This application is abandoned in view of:

1. Applicant's failure to timely file a proper reply to the Office letter mailed on 29 January 2003.
 - (a) A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) No reply has been received.
2. Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) The issue fee and publication fee, if applicable, has not been received.
3. Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) No corrected drawings have been received.
4. The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. The reason(s) below:

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ZOHREH FAY
PRIMARY EXAMINER
GROUP 1200
TECH CENTER 1600/2900
Zohreh Fay

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

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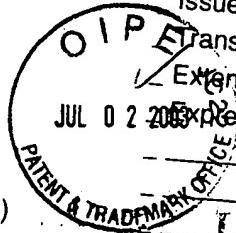


MAIL STOP AMENDMENT - FEE
Rec'd in USPTO/PCT Office. Date Stamp and Return Card.
Date: 6/30/2003 Serial No.: 10/039, 827, Conf. No 9534
Title: METHODS AND COMPOSITIONS FOR MODULATING..
Dkt. No.: 17349C1P(BAR)
Enclosed Are:

- Specification # _____, Claims # _____
and Abstract # _____
- Drawings (_____ sheets)
Formal _____ Informal
- Info. Disc. Statement
- Priority Documents # _____
- PTO 1449 W/References
- PCT Request (# pgs. _____)
- PCT Demand (# pgs. _____)
- PCT Response (# pgs. _____)
- PCT Amendment (# pgs. _____)
- Declaration, Power of Attorney
- Assignment & Cover Sheet
- Amendment (~~Final~~ (# pgs. 2))
- Certificate of Mailing
- Issue Fee Transmittal
- Transmittal Letter
- Extension of Time - 2 months
- Express Mail No. _____

MAIL STOP AMENDMENT - FEE
Rec'd in USPTO/PCT Office. Date Stamp and Return Card.
Date: 6/30/2003 Serial No.: 10/039, 827, Conf. No 9534
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and Abstract # _____
- Drawings (_____ sheets)
Formal _____ Informal
- Info. Disc. Statement
- Priority Documents # _____
- PTO 1449 W/References
- PCT Request (# pgs. _____)
- PCT Demand (# pgs. _____)
- PCT Response (# pgs. _____)
- PCT Amendment (# pgs. _____)
- Declaration, Power of Attorney
- Assignment & Cover Sheet
- Amendment (~~Final~~ (# pgs. 2))
- Certificate of Mailing
- Issue Fee Transmittal
- Transmittal Letter
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- Express Mail No. _____



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OFFICE OF PETITIONS, PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Chow et al.

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Serial No.: 10/039,827; Conf. No. 9534

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Filed: October 19, 2001

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For: METHODS AND COMPOSITIONS
FOR MODULATING ALPHA ADRENERGIC
RECEPTOR ACTIVITY

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Examiner: Fay, Z.

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Group Art Unit: 1614

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment Fee, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

Date of Deposit: 6/30/2003

Person making Deposit: Bonnie Ferguson

Signature: Bonnie Ferguson

Date of Signature: 6/30/2003

AMENDMENT

Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir,

This communication is in reply to the Office Action mailed January 29, 2003; Applicants have the following comments.

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USPTO

Serial No. : 10/039,827
Conf. No. : 9534
Filed : October 19, 2001

REMARKS

The Examiner has previously indicated that claim 4-6 are in condition for allowance. Applicants thank the Examiner for so indicating.

Rejection Pursuant to 35 USC §103(a)

The Examiner has again rejected claims 1-3, this time pursuant to 35 USC 103(a) as allegedly obvious over Chemical Abstracts 532428. This reference discloses that compounds "with diuretic and saluretic activity were prepared" having the structure:



in which R is an optionally substituted phenyl group and R₁, R₂ and R₃ are each selected from a large Markush group of possible substituents. Applicants respectfully traverse this rejection for the following reasons.

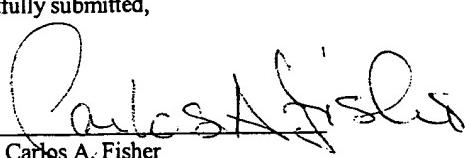
The Examiner states that the Applicants' point that rejected claims are drawn to compositions comprising a single compound and its esters and salts are not well taken because "it is expected that all the species of a genus have similar properties." However, this is precisely the Applicants' point. The cited abstract discloses properties (diuretic and saluretic activities) of the cited compounds that the presently claimed compound do not possess. Applicants are prepared to submit a declaration to that effect if necessary. Moreover, the present application discloses properties (analgesic properties) not disclosed in the prior art of record. Since the cited abstract does not specifically name or disclose the claimed compound, nor does it point one towards a compound having properties different from those disclosed in the citation, it cannot be considered obvious.

For this reason, Applicants respectfully ask that the Examiner reconsider the rejection of claims 1-3 and allow them to proceed to issue.

Please charge Deposit Account 01-0885 for the extension fees and any other fees due in this case.

Respectfully submitted,

Dated: 6/30/03

By: 
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